

Application No.: **10/773,757**  
Application Filed: **February 6, 2004**  
Please Direct All Correspondence to Customer Number **51476**

Attorney Docket No.: **10006-005A**  
Reply Brief Filed: **April 21, 2009**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicants	:	A. Carleton Elliott et al.
Appl. No.	:	10/773,757
Filed	:	February 6, 2004
For	:	COMPRESSION POST FOR STRUCTURAL SHEAR WALL
Examiner	:	Chi Q. Nguyen
Group Art Unit	:	3635
Confirmation No.	:	4027

**REPLY BRIEF**

**Mail Stop Appeal Brief-Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

In response to the February 23, 2009 Examiner's Answer, as modified by the March 23, 2009 Office Communication regarding "Evidence Relied Upon," Appellants submit this Reply Brief.

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## **I. REAL PARTY IN INTEREST**

The real party in interest remains as described in the Appeal Brief filed on December 8, 2008.

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## **II. RELATED APPEALS AND INTERFERENCES**

As set forth in the December 8, 2008 Appeal Brief, there are no related appeals and interferences.

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### **III. STATUS OF CLAIMS**

The status of the claims remains as set forth in the Appeal Brief, as confirmed in the Examiner's Answer.

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#### **IV. STATUS OF AMENDMENTS**

The status of the amendments remains as described in the December 8, 2008 Appeal Brief, as confirmed by the Examiner in the Examiner's Answer.

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#### **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The summary of the claimed subject matter remains as described in the December 8, 2008 Appeal Brief, as confirmed by the Examiner in the Examiner's Answer.

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#### **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The grounds of rejection to be reviewed on appeal remain as described in the December 8, 2008 Appeal Brief, as confirmed by the Examiner in the Examiner's Answer.

## **VII. ARGUMENT**

The Examiner's Answer includes two sections that present arguments in response to Appellants' Appeal Brief.

### **The Grounds of Rejection in Section (9) of the Examiner's Answer do not include any new ground of rejection**

The Grounds of Rejection set forth in Section (9) of the Examiner's Answer appear to be reproduced verbatim from the Detailed Action in the June 9, 2008 Final Office Action. Since Section (9) does not contain a new ground for rejection, Appellants respectfully submit that the arguments in the Appeal Brief (reproduced herein) are fully responsive to the Examiner's Grounds of Rejection in Section (9) of the Examiner's Answer.

### **The Response to Arguments in Section (10) of the Examiner's Answer is not responsive to Appellants' arguments in the Appeal Brief**

In Section (10) of the Examiner's Answer, the Examiner essentially reproduces the Response to Arguments on page 4 of the October 8, 2008 Final Office Action. In particular, the following annotated paragraph presents a comparison of the prior response in the Final Office Action and the current response in the Examiner's Answer, wherein text added in the Examiner's Answer is underlined and the deleted text is not shown:

Appellant argues: the prior art US Patent No. 6,015,139 to Weber does not disclose or suggest a compression post, an anchor device capable of being used in a shear wall positioned on a structural support; Weber does not disclose a compression post comprising a plate having a first surface mountable to a bottom surface of an end post of a shear wall; Weber does not disclose a first surface having dimensions selected to conform to the bottom surface of an end post; Weber does not disclose an extended portion having at least one dimension selected to fit through a hole in a mudsill of a shear wall; Weber does not disclose an

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extended portion having an exposed end displaced from the second surface by a length selected to conform to the thickness of the mudsill.

The appellant's arguments have been fully considered by the examiner; however, they are not persuasive because the appellant argued limitations are not positive claimed (e.g. a shear wall, mudsill, or structural support). The claims are solely drawn to a subcombination of a "compression post" and a combination with such shear wall, mudsill and structural support are not being positively claimed. Therefore it has been held that a recitation with respect to the manner in which a claimed which a claimed apparatus is intended to be employed does not different the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ F.2d 1647 (1987).

The Response to Arguments in the Examiner's Answer is inadequate in view of the requirements for the Response to Arguments set forth in MPEP § 1207.02

A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER.

The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

\* \* \*

10) *Response to Argument.* A statement of whether the examiner disagrees with each of the contentions of appellant in the brief with respect to the issues presented and an explanation of the reasons for disagreement with any such contention. The examiner must use headings and subheadings paralleling the headings and subheadings utilized in the appellant's brief.

The "Response to Arguments" is not responsive to Appellants' arguments in the December 8, 2008 Appeal Brief as required by MPEP § 1207.02. For example, the

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Appeal Brief included the following headings which require a response in the Examiner's Answer:

**Weber does not disclose or suggest a shear wall positioned on a structural support**

The Examiner's Answer does not dispute or otherwise respond to Appellants' arguments under this heading.

**Weber does not disclose or suggest a compression post**

The Examiner's Answer does not dispute or otherwise respond to Appellants' arguments under this heading.

**Weber does not disclose a plate having a first surface mountable to the bottom surface of an end post of a shear wall**

The Examiner's Answer does not dispute or otherwise respond to Appellants' arguments under this heading.

**The first surface of the plate in Weber does not have dimensions selected to conform to the bottom surface of the end post**

The Examiner's Answer does not dispute or otherwise respond to Appellants' arguments under this heading.

**The upstanding sleeve 12 of Weber does not have at least one dimension selected to fit through a hole in a mudsill of the shear wall**

The Examiner's Answer does not dispute or otherwise respond to Appellants' arguments under this heading.

**The Final Office Action does not properly consider the claimed dimensions of the compression post**

The Examiner's Answer does not dispute or otherwise respond to Appellants' arguments under this heading.

### **Summary of Arguments Presented in Reply Brief**

The Response to Arguments in the Examiner's Answer does not include any of the content required by MPEP § 1207.02. The Response to Arguments only presents conclusory statements that dismiss all of Appellant's arguments without presenting any support for the conclusion and without addressing any of Appellants' arguments. In particular, in the arguments in the Appeal Brief (reproduced below), Appellants traversed the Examiner's arguments that the shear wall, mudsill and structural support needed to be positively claimed. Appellants also presented extensive arguments regarding the claimed structural limitations that are not disclosed or suggested by Weber. Yet, the Examiner's Answer only repeats the original statements from the Final Office Action with no discussion of Appellants' arguments in the Appeal Brief.

Appellants have carefully reviewed the Examiner's Answer, and in particular, the Response to Arguments. There is nothing in the Response to Arguments or elsewhere in the Examiner's Answer to suggest that any of Appellants' arguments in the Appeal Brief were considered by the Examiner prior to preparing the Examiner's Answer. As a consequence, Appellants have been deprived of the opportunity to review and respond to the position of the Patent Office with respect to the arguments presented in the Appeal Brief. In order to assure that the arguments are fully considered, Appellants herewith present their original arguments on Appeal.

### **RESUBMISSION OF ARGUMENTS IN APPEAL BRIEF**

In reviewing the original December 8, 2008 Appeal Brief in response to the Examiner's Answer, Appellants noted errors in the Appeal Brief. Thus, in order to correct the errors and in order to present all of Appellants' arguments in a single paper, Appellants are submitting the arguments in the Appeal Brief in their entirety in the following paragraphs. The changes from the previously submitted arguments are identified by footnotes.

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**Independent Claim 1 is not anticipated by Weber and is patentably distinguished over Weber**

Appellants respectfully submit that the Final Office Action does not establish that independent Claim 1 is anticipated by Weber in accordance with 35 USC § 102(b).

In order to reject a claim based on anticipation under 35 USC § 102(b), the Final Office Action must satisfy the criteria set forth in MPEP § 2131:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Circ. 1987)

As set forth below, the stated bases for rejecting Claim 1 in the Final Office Action do not satisfy the requirements set forth in MPEP § 2131 as articulated in *Verdegaal*.

**Brief discussion of Weber**

As described in the Abstract of US Patent No. 6,015,139, Weber discloses:

An anchor system for removably mounting a stanchion to a grating floor formed from spaced grating members comprising a plate having upper and lower surfaces, a mounting location on the upper surface for releasably supporting the stanchion, and at least one locking member extending from the lower surface to releasably lock the plate to the grating floor. The locking member is formed with an extension adapted for movement from a position that allows the extension to be introduced between and below the spaced grating member to a position in which extension engages beneath one or more grating members to lock the plate onto the grating floor.

Figures 1, 2, 3 and 6 illustrate the pertinent elements of Weber:

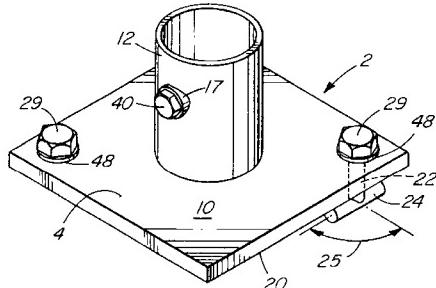


FIG. 1

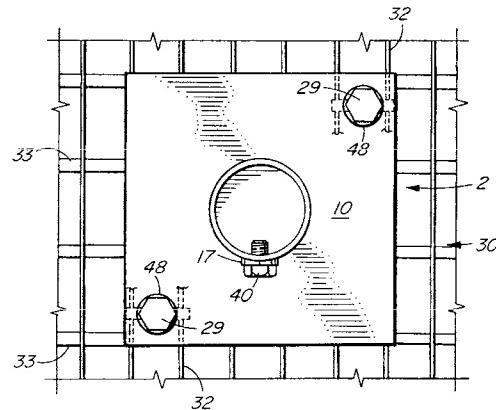


FIG. 2

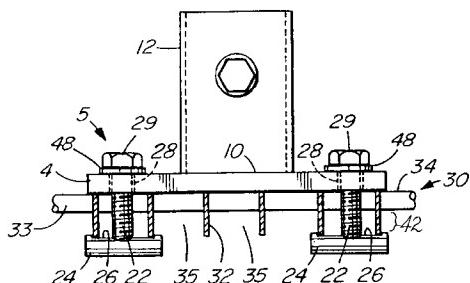


FIG. 3

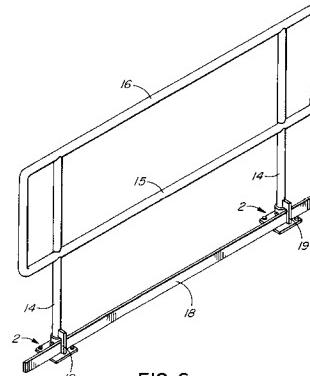


FIG. 6

As shown in Figures 1, 2, 3 and 6, the disclosed anchor 2 forms a base for a vertical guard rail stanchion 14, which supports horizontal rails 15 and 16. The base comprises a generally rectangular plate 4 that has a lower surface 20 that rests on a grating floor 30. The plate is mounted to the grating by at least one locking member 5 (comprising post 22, transverse member 24 and head 29). An upstanding sleeve 12 extends from an upper surface 10 of the plate. The upstanding sleeve receives the lower end of the guard rail stanchion.

**The rejection of Claim 1 is not well-founded in fact and law**

As the basis for the rejection of Claim 1, the Final Office Action states:

Weber disclose an anchor device 2 for capable of using in a shear wall that positioned on a structural support, the compression post comprising: a plate 10 having a first surface mountable to bottom surface of an end post of a shear wall, the first surface of the plate having dimensions selected to conform to the bottom surface of the end post, the plate having a second surface, generally parallel to the first surface; and an extended portion 12 positioned generally perpendicular to the second surface of the plate 10, the extended portion having at least one dimension selected to fit through a hole in a mudsill of the shear wall, the extended portion having an exposed end displaced from the second surface of the plate by a length selected to conform to a thickness of the mudsill such that when the compression post is mounted to the end post of the shear wall and the shear wall is mounted on a structural support, the exposed end of the extended portion rests on the structural support and forces applied to the compression post by the end post are communicated via the plate and the extended portion to the structural support (see Figs. 1-3).

In the following discussion, Appellants assume the citations to the “plate 10” of Weber in the Final Office Action are intended to be directed to the “plate 4” of Weber since the identifier numeral “10” refers to the upper surface of the plate 4.

**Weber does not disclose or suggest a shear wall positioned on a structural support**

As set forth in the preamble of Claim 1, the claimed compression post is defined in the context of a shear wall mounted on a structural support. The Final Office Action states that the anchor 2 of Weber is capable of being used in a shear wall positioned on a structural support; however, the Final Office Action does not cite any support for this

contention. The anchor 2 of Weber is only disclosed in the context of a base for an upright stanchion 14 of a guard rail. The Weber anchor is specifically configured to be mounted on a grating floor and includes a locking member 5 for securing the anchor to the grating members 32 of the grating floor. Nothing about the grating floor, the upright stanchion, or the guard rail of Weber remotely resemble a shear wall.

**Weber does not disclose or suggest a compression post**

In the first two lines of the rejection, the Final Office Action states that Weber discloses an anchor device 2, but then abruptly transitions to “the compression post comprising.” The Final Office Action provides no basis for stating that the anchor device of Weber is a compression post. As described above, the purpose of the Weber anchor is to provide a “mounting location for releasably supporting the stanchion” (Abstract). The “mounting location” is described in the specification as the upstanding sleeve 12. Weber does not suggest that the upstanding sleeve is in compression. Rather, it appears that the upstanding sleeve is intended to receive and provide circumferential support to the stanchion. The stanchion is locked into the upstanding sleeve by a bolt 40 received by a nut 17 shown in Figure 1 and described in column 3 at lines 53-57. It appears that the lower end of the stanchion rests on the upper surface of the plate 4<sup>1</sup> within the upstanding sleeve such that any compressive forces on the lower end of the stanchion are applied directly to the plate 4<sup>2</sup> of Weber rather than through the upstanding sleeve.

**Weber does not disclose a plate having a first surface mountable to the bottom surface of an end post of a shear wall**

Although the plate 4 of the anchor 2 of Weber may superficially resemble the plate defined in Claim 1, the plate of Weber does not have a first surface mountable to the bottom surface of an end post of a shear wall.

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<sup>1</sup> Correction of text of Appeal Brief, which incorrectly referred to the plate 10.

<sup>2</sup> Correction of text of Appeal Brief, which incorrectly referred to the plate 10.

The plate 4 of Weber has two surfaces. The upper surface 10 has the upstanding sleeve 12 extending upwardly from the surface. Thus, the upper surface of the plate is not mountable to the bottom surface of an end post of a shear wall.

The lower surface 20 of the plate 4 has the locking members 5 extending downwardly from the surface. Even if the anchor 2 were to be turned over so that the lower surface is facing upward, the locking members on the lower surface preclude the lower surface from being mountable to the bottom surface of an end post of a shear wall. The bottom surface of an end post does not have any feature corresponding to the grating members 32 to engage the locking members. Accordingly, the lower surface of the plate of Weber is not mountable to the bottom surface of an end post of a shear wall.

**The first surface of the plate in Weber does not have dimensions selected to conform to the bottom surface of the end post**

Although the Final Office Action states that the plate in Weber has dimensions selected to conform to the bottom surface of the end post, the Final Office Action does not cite any portion of Weber that supports the statement. The statement mischaracterizes the teachings of Weber because Weber is devoid of any suggestion of the dimensions of the plate or the dimensions of any other feature of the anchor. More particularly, Weber does not<sup>3</sup> teach or disclose any relationship between the size and shape of the plate and any other structure in Weber—and certainly not an end post, which has no relevance to the Weber disclosure.

**The upstanding sleeve 12 of Weber does not have at least one dimension selected to fit through a hole in a mudsill of the shear wall**

Although the Final Office Action states that the upstanding sleeve in Weber has dimensions selected to fit through a hole in a mudsill, the Final Office Action does not cite any portion of Weber that supports the statement. Weber is devoid of any

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<sup>3</sup> Correction of text of Appeal Brief, which inadvertently omitted word “not”.

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suggestion of the dimensions of the upstanding sleeve. Furthermore, no mudsill having a hole is shown by which the outer diameter of the upstanding sleeve can be determined with respect to any such hole.

**The upstanding sleeve 12 of Weber does not have the length that conforms to the thickness of the mudsill**

The Final Office Action states that the upstanding sleeve (the extended portion) of Weber has:

an exposed end displaced from the second surface of the plate by a length selected to conform to a thickness of the mudsill such that when the compression post is mounted to the end post of the shear wall and the shear wall is mounted on a structural support, the exposed end of the extended portion rests on the structural support and forces applied to the compression post by the end post are communicated via the plate and the extended portion to the structural support.

The Final Office Action cites Figures 1-3 of Weber as showing this feature; however, there is no support for the foregoing statements.

Although the upstanding sleeve 14 is shown in Figures 1-3 of Weber, the length of the upstanding sleeve is not suggested in Figures 1-3 or in the corresponding text. No mudsill is shown or suggested in the figures or in the text. Accordingly, there is no support whatsoever for the statement that the length of the upstanding sleeve conforms to the thickness of the mudsill or that the exposed end of the upstanding sleeve rests on a structural support (e.g., a foundation) so that forces from an end post are communicated via the plate and the upstanding sleeve to the structural support.

**The Final Office Action does not properly consider the claimed dimensions of the compression post**

In the paragraph on pages 8 and 9 of the October 9, 2008 Final Office Action, the Examiner responds to Appellants previously submitted arguments as follows:

Applicant argues: Weber does not disclose an anchor device capable of being used in a shear wall positioned on a structural support; Weber does not disclose a compression post comprising a plate having a first surface mountable to a bottom surface of an end post of a shear wall; Weber does not disclose a first surface having dimensions selected to conform to the bottom surface of an end post; Weber does not disclose an extended portion having at least one dimension selected to fit through a hole in a mudsill of a shear wall; Weber does not disclose an extended portion having an exposed end displaced from the second surface by a length selected to conform to the thickness of the mudsill. The applicant's arguments have been fully considered but they are not persuasive because the applicant's argued limitations are not positive claimed, e.g. a shear wall, mudsill, or structural support is not positively claimed with a compression post and it has been held that a recitation with respect to the manner in which a claimed which a claimed apparatus is intended to be employed does not different the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ 2d 1647 (1987).

Appellants respectfully disagree. Appellants have indeed positively claimed the dimensions of the compression post. The statement that the applicant's argued limitations are not positively claimed represents a fundamental misunderstanding of the claimed invention. The shear wall, the mudsill and the structural support are not part of the claimed invention. Rather, the shear wall, the mudsill and the structural support are

referenced in Claim 1 to enable Appellants to positively claim the dimensions of the compression post using dimensions with which a person skilled in the wood-framed building construction art is familiar.

In the building construction art, stating that the extended portion has a length that conforms to the “thickness” of the mudsill is the recitation of a dimension in the same manner as if the length had been stated as a specific length with respect to a standard measurement system in inches or millimeters. More particularly, the claimed dimensions are more accurate because the person skilled in the art is able to relate the dimensions to the dimensions of the lumber used for the mudsill and the end post. As described in the specification, if the end post or the mudsill has different dimensions, the dimensions of the plate and the length of the extended portion are selected to conform to the dimensions. Referencing the length of the extended portion to the thickness of the mudsill does not cause the mudsill to be part of the claimed invention any more than stating that the length is 1.5 inches, for example, would cause the gradations on a measurement device (e.g., a carpenter’s scale or a tape measure) to be part of the claimed invention.

**Summary of arguments that Claim 1 is not anticipated by Weber and is  
patentably distinguished over Weber**

As set forth in detail in the foregoing paragraphs, the Final Office Action does not set forth a sufficient basis for supporting the rejection of Claim 1 under 35 USC § 102(b) as being anticipated by Weber for at least the following reasons:

Weber does not disclose or suggest a shear wall positioned on a structural support;

Weber does not disclose or suggest a compression post;

Weber does not disclose a plate having a first surface mountable to the bottom surface of an end post of a shear wall;

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The first surface of the plate in Weber does not have dimensions

selected to conform to the bottom surface of the end post;

The upstanding sleeve 12 of Weber does not have at least one

dimension selected to fit through a hole in a mudsill of the shear  
wall; and

The Final Office Action does not properly consider the claimed

dimensions of the compression post.

**The stated bases for the anticipation rejection in the Final Office Action are also insufficient to support a rejection of Claim 1 under the obviousness standards of the USPTO**

In addition to not presenting sufficient bases for rejecting Claim 1 as being anticipated under 35 USC § 102(b), the Final Office Action also does not present sufficient bases for rejecting Claim 1 as being obvious under 35 USC § 103(a) for at least the reasons set forth below.

**The rejection in the Final Office Action does not satisfy the requirements of the Supreme Court decision in *Graham v. John Deere***

The rejection in the Final Office Action does not address any of the factual inquiries required by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) summarized in MPEP 1504.03:

- (A) Determining the scope and content of the prior art;
- (B) Ascertaining the differences between the claimed invention and the prior art;
- (C) Resolving the level of ordinary skill in the art; and
- (D) Evaluating any objective evidence of nonobviousness (i.e., so-called "secondary considerations").

**The rejection in the Final Office Action does not satisfy the requirements of the Supreme Court decision in KSR**

The rejection also does not identify any rationale for supporting a conclusion of obviousness in accordance with the Supreme Court decision in *KSR International Co. v. Teleflex Inc.* (*KSR*), 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007), as discussed in the "Examination Guidelines for Determining Obviousness under 35 U.S.C. 103" set forth in MPEP 2141. In particular, the Final Office Action does not address any of the following seven exemplary rationales suggested in *KSR* and reproduced in MPEP 2141, which must be applied after completing the factual inquiries required by *Graham v. John Deere*:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art

reference or to combine prior art reference teachings to arrive at the claimed invention.

Nothing in the Final Office Action suggests a starting point for discussing exemplary rationales (A)-(E). Even if the Final Office Action could be said to suggest that the rejection is based on the exemplary rationale (F) or the exemplary rationale (G), the Final Office Action does not set forth the requirements for a rejection under either rationale.

With respect to rationale (F), the Final Office Action does not set forth any design incentives or market forces that would suggest to a person of ordinary skill to modify the stanchion anchor of Weber for use on a grating floor to create a compression post that mounts on an end support post in a shear wall and that extends through the mudsill of the shear wall to rest on a solid foundation.

With respect to rationale (G), the Final Office Action does not include any teaching, suggestion or motivation in Weber or any other prior art that would have led a person of ordinary skill to modify the Weber stanchion anchor to arrive at the claimed invention. A person of ordinary skill would only consider the required modification of Weber with the benefit of hindsight after reviewing the claimed invention.

### **The rejection does not consider the invention as a whole**

As set forth in MPEP 2141.02, Section I, in determining patentability of a claimed invention over prior art references, the invention must be considered as a whole:

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

Appellants' discovery of the source/cause of the perceived problems in crushing the mudsill in conventional wall structures subject to shear was itself part of the "whole" invention. As set forth in MPEP 2141.02, Section III:

"[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103." *In re Sponnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969). However, "discovery of the cause of a problem . . . does not always result in a patentable invention. . . . [A] different situation exists where the solution is obvious from prior art which contains the same solution for a similar problem." *In re Wiseman*, 596 F.2d 1019, 1022, 201 USPQ 658, 661 (CCPA 1979) (emphasis in original).

When the required consideration is made with respect to the subject matter of the present application, the conclusion is inescapable. Appellants solved a problem that they discovered in wall structures for wood-framed buildings that are subject to shear caused by seismic events and strong wind events. Appellants discovered that the forces applied to the mudsill via the end posts could crush the mudsill and result in permanent damage to the shear wall. Appellants further discovered that by creating a compression post that is mountable to the lower surface of the end post with an extended portion of the compression post extending through the mudsill, the forces on the end post bypass the mudsill and are communicated directly to the underlying support structure. Thus, no crushing effect is applied to the mudsill by the end posts.

The blind application of Weber in the Final Office Action does not consider in any manner the claimed dimensions of the compression post that define the structure of the compression post. Appellants did not invent a "plate and an extended portion," which appears to be the only limitations from Claim 1 considered in the Final Office Action.

Rather, Appellants defined compression post comprises a plate and an extended portion, which have the specifically defined dimensional limitations that fully distinguish the claimed compression post from Weber and from any other prior art devices of record that may have a plate and an extended portion.

**The required modifications to Weber would render Weber unsatisfactory for its intended purpose**

As discussed above, the anchor 2 of Weber could not be mounted onto an end post because the locking members 5 of Weber preclude such mounting. If the anchor 2 of Weber were to be modified by removing the locking members 5 from the lower surface 20 of the plate 4, the resulting structure still would not satisfy the dimensional limitations in Claim 1. Furthermore, such a modification of the anchor would render the anchor unsatisfactory for its intended purpose of engaging the grating members 32 and supporting the upright stanchion. Such a modification of Weber could not support an obviousness rejection in view of *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir 1984), cited in MPEP § 2143.01. The modification would change the principle of operation of Weber. Thus, the teaching of Weber is not sufficient to render Claim 1 *prima facie* obvious in accordance with *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), as cited in MPEP § 2143.01.

**Summary of arguments regarding patentability of Claim 1**

In summary, in citing Weber, the Final Office Action mischaracterizes the teachings of Weber and ignores the dimensional limitations in Claim 1. Furthermore, in citing Weber from non-analogous art, the Final Office Action does not consider the invention as whole. Rather, the Final Office Action focuses solely on certain similarities in the appearance of Weber without considering the limitations that define the structure of the claimed compression post, limitations that are not disclosed or suggested by Weber.

Appellants respectfully submit that Claim 1 is not anticipated by Weber and is not obvious in view of Weber. Appellants respectfully request the Board to reverse the

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rejection of Claim 1 under 35 USC § 102(b), and Appellants further request the Board to direct the Examiner to allow Claim 1.

**Claim 2 is not anticipated by Weber and is patentably distinguished over Weber**

Claim 2 depends from Claim 1 and further defines the invention defined in Claim 1 wherein the extended portion is secured to the plate. In view of the patentability of Claim 1 over Weber, as discussed above, Appellants respectfully submit that Claim 2 is also patentably distinguished over Weber for at least the foregoing reasons.

Appellants respectfully request the Board to reverse the rejection of Claim 2 based on Weber. Appellants further request the Board to direct the Examiner to allow Claim 2.

**Claim 8 is not anticipated by Weber and is patentably distinguished over Weber**

Claim 8 depends from Claim 1 and further defines the invention defined in Claim 1 wherein the extended portion is cylindrical and the at least one dimension is an outside diameter. In view of the patentability of Claim 1 over Weber, as discussed above, Appellants respectfully submit that Claim 8 is also patentably distinguished over Weber for at least the foregoing reasons.

Appellants respectfully request the Board to reverse the rejection of Claim 8 based on Weber. Appellants further request the Board to direct the Examiner to allow Claim 8.

**Claim 3 is patentably distinguished over Weber**

The Final Office Action rejects Claim 3 under 35 USC § 103(a) as being unpatentable over Weber. In particular, the Final Office Action states:

Weber discloses the basic structures as stated but does not expressly disclose wherein the extended portion is secured to the plate by at least one weld. However, this feature would have been a matter of

obvious design choice to one of ordinary skill in the art at the time the invention was made to secure the plate and the extension portion together by weld as a well-known method in the art that how to connect two members. Furthermore, applicant has not disclosed the criticality of this feature.

Claim 3 depends from Claim 1 and further defines the invention defined in Claim 1 wherein the extended portion is secured to the plate by at least one weld. In view of the patentability of Claim 1 over Weber, Appellants respectfully submit that Claim 3 is also patentably distinguished over Weber for at least the foregoing reasons.

Appellants respectfully request the Board to reverse the rejection of Claim 3 based on Weber. Appellants further request the Board to direct the Examiner to allow Claim 3.

### **Summary of Arguments originally presented in Appeal Brief**

In view of the foregoing Argument, Appellants respectfully submit that the rejections of Claims 1, 2 and 8 as being anticipated by Weber are not well founded. Furthermore, Claims 1, 2 and 8 are patentably distinguished over Weber. Appellants further submit that dependent Claim 3 is patentably distinguished over Weber. Appellants respectfully request the Board to reverse the rejection of Claims 1, 2 and 8 under 35 USC § 102(b) and to reverse the rejection of Claim 3 under 35 USC § 103(a). Appellants further request the Board to direct the Examiner to allow Claims 1-3 and 8.

### **Request for Reversal of Final Rejection**

In view of the foregoing arguments in this Reply Brief and in further view of the arguments reproduced above from the December 8, 2008 Appeal Brief, Appellants respectfully submit that the rejections of Claims 1, 2 and 8 as being anticipated by Weber are not well founded. Furthermore, as further discussed in the Appeal Brief, Claims 1, 2 and 8 are patentably distinguished over Weber. Appellants further submit that dependent Claim 3 is patentably distinguished over Weber for the reasons set forth

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in the Appeal Brief. Appellants respectfully request the Board to reverse the rejection of Claims 1, 2 and 8 under 35 USC § 102(b) and to reverse the rejection of Claim 3 under 35 USC § 103(a). Appellants further request the Board to direct the Examiner to allow Claims 1-3 and 8.

#### **Request for Rejoinder of Withdrawn Claims 4-7**

Dependent Claims 4-7 depend from Claim 1 and further define specific embodiments of the compression post having differing structural relationships between the plate and the extended portion. In view of the patentability of independent Claim 1, as argued herein, Appellants respectfully submit that dependent Claims 4-7 should be rejoined in this application. Appellants respectfully request the Board to direct the Examiner to rejoin Claims 4-7 and to allow Claims 4-7 in addition to Claims 1-3 and 8.

#### **Request for Oral Hearing**

Appellants are submitting herewith a Request for Oral Hearing and the required fee for the Oral Hearing. Appellants and their attorney of record reside in California, and Appellants respectfully request the Board to call the undersigned attorney of record to schedule the Oral Hearing at a time when the undersigned attorney and a representative of Appellants can appear before the Board in connection with other travel to the Patent Office.

Respectfully submitted,  
Attorney for Appellants

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April 21, 2009

Date

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### **VIII. CLAIMS APPENDIX**

**Claim 1** (rejected) A compression post for a shear wall positioned on a structural support, the compression post comprising:

a plate having a first surface mountable to a bottom surface of an end post of a shear wall, the first surface of the plate having dimensions selected to conform to the bottom surface of the end post, the plate having a second surface generally parallel to the first surface; and

an extended portion positioned generally perpendicular to the second surface of the plate, the extended portion having at least one dimension selected to fit through a hole in a mudsill of the shear wall, the extended portion having an exposed end displaced from the second surface of the plate by a length selected to conform to a thickness of the mudsill such that when the compression post is mounted to the end post of the shear wall and the shear wall is mounted on a structural support, the exposed end of the extended portion rests on the structural support and forces applied to the compression post by the end post are communicated via the plate and the extended portion to the structural support.

**Claim 2** (rejected) The compression post of Claim 1, wherein the extended portion is secured to the plate.

**Claim 3** (rejected) The compression post of Claim 1, wherein the extended portion is secured to the plate by at least one weld.

**Claim 4** (withdrawn) The compression post of Claim 1, wherein the extended portion is secured to the plate by press fitting an end of the extended portion into a recess in the plate.

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**Claim 5** (withdrawn) The compression post of Claim 1, wherein:

- one end of the extended portion is threaded;
- the plate includes a threaded bore; and
- the threaded end of the extended portion is engageable with the threaded bore to secure the extended portion to the plate.

**Claim 6** (withdrawn) The compression post of Claim 1, further comprising:

- an endcap on at least one end of the extended portion, the endcap having a bore there through;
- a threaded bore in the plate; and
- a bolt sized to extend through the bore of the endcap, the bolt having a threaded end engageable with the threaded bore in the plate to secure the extended portion to the plate.

**Claim 7** (withdrawn) The compression post of Claim 1, wherein the extended portion and the plate comprise a cast unitary body.

**Claim 8** (rejected) The compression post of Claim 1, wherein the extended portion is cylindrical and the at least one dimension is an outside diameter.

**Claims 9–17** (canceled)

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## **IX. EVIDENCE APPENDIX**

None

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#### **X. RELATED PROCEEDINGS APPENDIX**

None